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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/711,548

09/24/2004

Ryuichiro Takamoto

SIC-04-012

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10/10/2006

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EXAMINER

ARCE DIAZ, MARLON A

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 10/10/2006

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/711,548  
Filing Date: September 24, 2004  
Appellant(s): TAKAMOTO ET AL.

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Ryuichiro Takamoto  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/17/06 appealing from the Office action  
mailed 4/6/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

20030071436

Fujii

4-2003

**(9) Grounds of Rejection**

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The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-21 stand rejected under 35 U.S.C. 102(a) as being unpatentable by Fujii (U.S. Publication No. 2003/0071436 A1). Fujii discloses a threshold value setting unit 30, a decision unit (step S23, para. 29 line 11) that decides if the bicycle speed/crank RPM (para. 3) of the current running condition passes the threshold value, a tentative shift unit (step S25, para. 30 line 6), a canceling unit (step S24 para. 30 line 4), a control unit 25 that provides a signal to upshift or downshift the bicycle transmission when the current running condition value passes the threshold value a plurality of times consecutively or for a predetermined time period (para 30 line 16), and a decision unit receiving a plurality of running condition values from a single revolution of a bicycle wheel (para. 4) or from an alternating current generator (para. 24).
2. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### **(10) Response to Argument**

A statement identifying by name the real party in interest is contained in the brief. The appeal brief filed on 9/24/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the prior reference used in final rejection Fujii (US Pub 2003/0071436). Applicant argues that there are a couple of distinct parts between the claimed subject matter and the prior art used on the rejection. First applicant believes that step S24 does not read on claim 1 as written; examiner likes to point out that Fujii

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does indeed take two separate measurements of the speed S as said on Paragraph 0030 where it states "When the current wheel speed S exceeds the upshift threshold value U (VP) for the current speed step, the process moves from step S23 to step S25. For example, when VP=2 (second gear), the process moves from step S23 to step S25 whenever the wheel speed is greater than 16 km/h. In step S25, a decision is made whether or not a time interval T1 has passed since the decision at step S23. If not, the wheel speed is acquired again in step S26. In step S27, a decision is made as to whether the reacquired current wheel speed S exceeds the upshift threshold value U (VP) for the current speed step. If wheel speed S does not exceed the upshift threshold value U (VP), the process moves to step S24 to cancel the potential upshift operation". Meaning that, there is a couple of decision being made before the cancellation of the upshift, such as, step 23 taking a speed S to make sure that it is greater than the preset speed (Threshold value U (VP)), step 25 then decides if a time T1 has elapsed after the speed measured is greater than 16 km/h. If the time interval has not passed, the speed S is acquired again in step S26, then, step S27 decides if the newly acquired speed S (acquired in step S26) is greater than the upshift threshold speed U (VP). If the speed S (acquired in step 26) does not exceed the preset speed (threshold value U (VP)) the upshift is cancelled in step S24. Examiner believes that there are two measurements of the speed S taken, one in step S23 and then again in step S26 meaning that a decision is made on whether the current condition value (speed) varies from a previous condition value (speed), in order to have the cancellation of the upshift in step S24. In other words the threshold value is a preset speed value, in step S23 the speed is compared to the

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threshold value, if it is, then step S25 makes a decision on the time elapsed, then, step S26 retakes the speed so that step S27 can decide on whether the speed taken in step S26 exceeds the preset speed. If not, step S24 cancels the upshift. Second applicant argues that claim 1 mentions comparing two separate speeds that have been measured at different times; examiner likes to point out that, claim 1 specifically mentions the cancellation of the upshift if the decision unit decides that the current running condition value varies from a previous running condition value, meaning that only the speed only has to vary from a previous speed without comparing them; Fujii discloses the speed being measured (step S23) and then measured again (step S26) in order to decide the cancellation of the upshift (step S24).

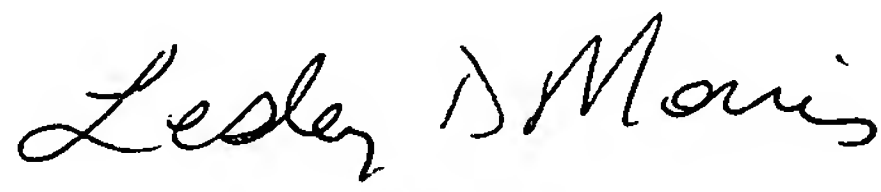
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Marlon Arce-Diaz, 9/27/06

  
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